



**REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 2834
PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q66775

Yoshihito ASAO, et al.

Appln. No.: 09/978,548

Group Art Unit: 2834

Confirmation No.: 5255

Examiner: Tran N. NGUYEN

Filed: October 18, 2001

For: ALTERNATOR AND METHOD OF MANUFACTURE THEREFOR

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 4, 2003, reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Request, claims 22-30 are pending in the application. Applicant respectfully submits the pending claims define patentable subject matter.

In the Office Action, claims 22-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner contends that “[c]laims 23-28 contain method claimed language which does not further set the limitations of the structure of the claimed alternator, but rather the method of fabricating the alternator with assembly processing steps.” Further, the Examiner indicates that “[i]n a so-called product-by-process apparatus claimed

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invention, the method of forming the device is not germane to the issue of patentability of the device itself (*In re Thorpe*, 227 USPQ 964, 966).” However, the Examiner does not explain why the product-by-process format of the claims renders the claims indefinite. Moreover, *In re Thorpe* stands the proposition that a determination of patentability over the prior art in product-by-process claims is based on the product itself (not that product-by-process claims are *per se* indefinite).

Nowhere does the case law (e.g., *In re Thorpe*) or the MPEP indicate that product-by-process claims are indefinite.¹ To the contrary, it is well settled that a product-by-process claim, which is a product claim that defines the claimed invention in terms of the process by which it is made, is proper. *In re Luck* 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Further, an applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 41 (Bd. App. 1972). See MPEP 2173.05(p). Thus, it appears the Examiner does not understand or is choosing to ignore product-by-process claim procedure.

Accordingly, Applicant respectfully requests that the § 112, second paragraph, rejection be withdrawn because claims 22-28 are both definite and entirely proper under 35 U.S.C. § 112.

Claims 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of pending U.S. Appln. No. 09/624,222 in

¹ The Examiner may be confusing claims 22-28 with claims which recite both an apparatus and the method steps of using the apparatus which are indefinite under 35 U.S.C. § 112, second paragraph (see MPEP 2173.05(q)). However, claims 22-28 recite an apparatus and the method steps of manufacturing the apparatus.

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view of Adachi (JP 09103052A) and Tamaka et al. (USP 4,876,473). Claims 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Appln. No. 09/734,680 (which issued as U.S. Patent No. 6,498,413) in view of Adachi and Tamaka et al.

In the Amendment filed March 19, 2003, Applicant argued that the double patenting rejection based on Appln. No. 09/624,222 is improper because Appln. No. 09/624,222 may not be used as a reference against the present application in a double patenting rejection. That is, since the present application is a divisional application under 35 U.S.C. § 1.53(b) of U.S. Appln. No. 09/624,222 and was filed due to a restriction requirement therein, 35 U.S.C. § 121 prohibits U.S. Appln. No. 09/624,222 from being used as a reference against the present application in a double patenting rejection.

In response, the Examiner (page 6 of the Office Action) asserts that the double patenting rejection based on Appln. No. 09/624,222 is proper because the Restriction Requirement restricted the device's structure claims (group I) and the method claims for the device's fabricating/assembling process (group 2), and "this divisional application is not [directed to] the method claims for the device's fabricating/assembling process ..., [rather] the present application is [directed to] a structure claim of the device with additional method of forming the device, which is not germane to the issue of patentability of the device itself." However, claims 22-30 are substantially identical to original claims 2-10, and in the Restriction Requirement dated September 25, 2001, the Examiner stated claim 1 and claims 2-10 are directed to distinct inventions because "claim 1 is drawn to a structure of a stator winding assembly used in an

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electric motor, classified in class 310, subclass 179” and “claims 2-10 are drawn to [a] method of making a stator winding assembly, classified in class 29, subclass 596” (emphasis added). Thus, the Examiner is again ignoring her own statements used in support of the Restriction Requirement.

Nonetheless, in order to expedite prosecution, Applicant is submitting a terminal disclaimer with regard to Application No. 09/624,222 and Patent No. 6,498,413. Accordingly, the Examiner is requested to remove the double patenting rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373

CUSTOMER NUMBER

Date: November 4, 2003

Attorney Docket No.: Q66775